

Preliminary amendment dated February 7, 2006
Appl. No. 10/781,296
Filed February 18, 2004

REMARKS

Applicants filed a Request for Continued Examination of this application on February 2, 2006. This amendment satisfies the submission requirement for RCE under 37 C.F.R. § 1.114.

Because the prior amendment submitted on April 18, 2005 was not entered due to non-compliance, applicants resubmit their prior amendments to address the rejections presented in the prior Office Action of October 14, 2004.

Reconsideration of the subject patent application in light of the present Amendment and Remarks is respectfully requested. This amendment has been made to put this application in condition for immediate allowance.

Claims 1-50 are pending. Claim 19 has been amended to more particularly point out and distinctly claim applicants' invention by adding the term "reacting" instead of treating. Claims 21, 42, 46, and 49 have been amended to correct typographical errors. Claims 10-18 and 23-24 have been canceled. No new matter has been added.

Entry of this Amendment is respectfully requested. Upon entry of the amendment, Claims 1-9, 19-22, and 25 to 50 will be pending.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 4-5, 7-9, 13-14 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement since the term "more" does not have adequate support in the specification. Applicant respectfully traverses. A person of ordinary skill in the art would understand that once one lysine is attached to the 2 or 6 position of the ascorbate compound that the next amino acid would be attached to the first amino acid by a peptide bond. The standard practice in the arts is to describe a series of amino acids by naming them in sequence and it is understood that each amino acid is attached to the next amino acid in sequence by a peptide bond. Likewise, a series of lysines would be understood to be attached by peptide bonds as well. We therefore believe that the

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specification does support the term "more" since a person of ordinary skill in the art would understand that "more" lysines are attached by peptide bonds. Claims 13-14 have been cancelled. Applicants respectfully request reconsideration and withdrawal of the rejection of pending Claims 4-5 and 7-9 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 19-45 and 47-50 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 19 to remove the term treating and replace it with the term "reacting" to clarify the combination of the components of the composition. Applicants assert that the term "isolating" is sufficiently clear to a person of skill in the art to understand the steps to isolate the product from the reaction mixture. The Examples specifically exemplify the various steps involved with isolating the product from solution. For example in Example 4 pyridine is removed under reduced pressure, the reaction mixture is extracted and the organic phase is dried with sodium sulfate, and the product is crystallized from out of the solution using ethanol. As, claims 23 and 24 have been cancelled and claim 19 has been amended, we believe that claims 19-22, 25-45 and 47-50 particularly point out and distinctly claim the subject matter of the invention and Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph

Rejection under 35 U.S.C. § 103(a)

Claims 1-18 and 46-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rath et al., EP 0891771 A1.

Applicants respectfully traverse. EP0891771 claims a composition comprising ascorbic acid with lysine or proline or both, which could be covalently linked to the ascorbic acid at any position. The Examiner stated that the statement in the present application at pg 3, lines 18-27 that many ascorbate compounds substituted at C2 and C6 have been previously made gives motivation to a skilled artisan, in view of EP0891771, to covalently link the

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lysine or proline to the ascorbic acid compound at positions C2 and C6 obvious. Applicant notes that the background of the present application indicates that ascorbic acid has several reactive hydroxy groups that can be used to form ascorbate derivatives and that substitution at C5, C6, C2 and C3 have been made.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be reasonable expectation of success. Third, the prior art references, when combined, must teach or suggest all the claimed elements.

Here, there is no suggestion or motivation to covalently link lysine or proline specifically to the C-2 or C-6 position of the ascorbate compound by combining any of the references cited by the examiner and EP0891771.

Claims 10-18 have been cancelled. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of pending Claims 1-9 and 46-50 under 35 U.S.C. § 103(a).

Claims 10-18, 23-24 are provisionally rejected for double patenting under 35 USC 101 as claiming same invention of allowed application 10/226,588. Applicants have cancelled claims 10-18 and 23-24. Accordingly, Applicants request reconsideration and withdrawal of the rejection of pending claims 1-9, 19-22, and 25 to 50 under 35 USC 101.

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CONCLUSION

Applicant believes that this Application is now in condition for allowance and such action is respectfully requested. If for any reason the Examiner believes that contact with the Applicant's attorney would advance the prosecution of this application, he is invited to contact the undersigned at the number given below.

Respectfully Submitted,

Dated: February 7, 2006

By: 

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